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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,890	02/04/2004	Jeffrey Gabbay	082799-000100US	5373
20350	7590	01/18/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			STITZEL, DAVID PAUL	
		ART UNIT	PAPER NUMBER	
		1616		

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/772,890	GABBAY, JEFFREY
	<b>Examiner</b> David P. Stitzel, Esq.	<b>Art Unit</b> 1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-28 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**OFFICIAL ACTION**

***Restriction/Election***

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1-3 are drawn to a method of making a hydrophilic polymeric material, classified in class 148, subclass 251.
- II. Claims 4-9 and 27-28 are drawn to a hydrophilic polymeric material, classified in class 424, subclass 630.
- III. Claims 10-11 are drawn to a nipple device formed from a hydrophilic polymeric material, classified in class 222, subclass 490.
- IV. Claims 12-14 are drawn to a bag device formed from a hydrophilic polymeric material, classified in class 427, subclass 2.3.
- V. Claims 15-18 are drawn to a tube device formed from a hydrophilic polymeric material, classified in class 427, subclass 2.3.
- VI. Claims 19-20 are drawn to a condom device formed from a hydrophilic polymeric material, classified in class 427, subclass 2.3.
- VII. Claims 21-22 are drawn to a diaphragm device formed from a hydrophilic polymeric material, classified in class 427, subclass 2.3.
- VIII. Claims 23-26 are drawn to a glove device formed from a hydrophilic polymeric material, classified in class 427, subclass 2.3.

Inventions I and II are related as a method of making a product and said product. The inventions can be shown to be distinct if either or both of the following can be shown that: (1) the method of making the product as claimed can be used to make a materially different product; or (2) the product as claimed

can be made by another method that is materially different from the instantly claimed method of making said product. See MPEP § 806.05(f). In the instant case, a product as claimed in Invention II can be made by a materially different method from the method claimed in Invention I. For example, as opposed to a method of making a hydrophilic polymeric material containing cupric ion ( $Cu^{++}$ ) and cuprous ion ( $Cu^+$ ), wherein said method comprises: preparing a hydrophilic polymeric slurry; dispersing an ionic copper powder mixture containing cupric ion ( $Cu^{++}$ ) and cuprous ion ( $Cu^+$ ) in said hydrophilic polymeric slurry; and extruding said hydrophilic polymeric slurry to form said hydrophilic polymeric material containing cupric ion ( $Cu^{++}$ ) and cuprous ion ( $Cu^+$ ), as claimed in Invention I; alternatively, a dry process may be used to make said hydrophilic polymeric material containing cupric ion ( $Cu^{++}$ ) and cuprous ion ( $Cu^+$ ), wherein said process comprises: providing a polymerizable hydrophilic monomer and an ionic copper compound, which contains cupric ion ( $Cu^{++}$ ) and/or cuprous ion ( $Cu^+$ ), onto a support area; and heat polymerizing said polymerizable hydrophilic monomer in the presence of said ionic copper compound to form said hydrophilic polymeric material containing cupric ion ( $Cu^{++}$ ) and/or cuprous ion ( $Cu^+$ ).

Invention I is unrelated to Inventions III-VIII. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. See MPEP §§ 806.04 and 808.01. In the instant case, the method as claimed in Invention I has an effect of yielding a hydrophilic polymeric material containing cupric ion ( $Cu^{++}$ ) and cuprous ion ( $Cu^+$ ), whereas the devices claimed in Inventions III-VIII have an effect of inactivating a virus brought into contact therewith. As a result, the method as claimed in Invention I has a materially different effect from the devices claimed in Inventions III-VIII and are therefore unrelated.

Invention II is unrelated to Inventions III-VIII. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. See MPEP §§ 806.04 and 808.01. In the instant case, the product comprising a hydrophilic polymeric material containing cupric ion ( $Cu^{++}$ ) and cuprous ion ( $Cu^{+}$ ), as claimed in Invention I, may constitute a light-sensitive recording material having an effect of forming a latent image, whereas the devices claimed in Inventions III-VIII have an effect of inactivating a virus brought into contact therewith. As a result, the product as claimed in Invention II has a materially different effect from the devices claimed in Inventions III-VIII and are therefore unrelated.

Inventions III-VIII are unrelated, each with respect to the others. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. See MPEP §§ 806.04 and 808.01. In the instant case, each of the respective devices, as claimed in Inventions III (nipple device), IV (bag device), V (tube device), VI (condom device), VII (diaphragm device), and VIII (glove device), are not disclosed as capable of being used together, and each of the aforementioned respective devices have different modes of operation. As a result, each of the respective devices, as claimed in Inventions III-VIII, are not disclosed as being capable of being used together, as well as have different modes of operation, and are therefore unrelated.

Because these inventions are independent and distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the prior art search required for each respective invention would be divergent, thereby causing an undue search burden. As a result, restriction for examination purposes as indicated is proper. Applicant is therefore required under 35 U.S.C. § 121 to elect a single invention for prosecution on the merits.

***Conclusion to Restriction Requirement***

The Examiner has required restriction between product, methods of making and device claims. Where Applicant elects claims directed to a product, and the product claim is subsequently found allowable, withdrawn methods of making claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Methods of making claims that depend from or otherwise include all the limitations of the patentable product claim will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined methods of making claims will be withdrawn, and the rejoined methods of making claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. §§ 101, 102, 103 and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and methods of making claims may be maintained. Withdrawn methods of making claims that are not commensurate in scope with an allowed product claim will not be rejoined. See “Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b),” 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the methods of making claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. § 121 does not apply

where the restriction requirement is withdrawn by the Examiner before the patent issues. See MPEP § 804.01.

Due to the complex nature of the instant restriction requirement, a written restriction requirement was necessitated. See MPEP § 812.01.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to David P. Stitzel, Esq. whose telephone number is 571-272-8508. The Examiner can normally be reached on Monday-Friday, from 7:30AM-6:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Sreenivasan Padmanabhan can be reached at 571-272-0629. The central fax number for the USPTO is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published patent applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished patent applications is only available through Private PAIR. For more information about the PAIR system, please see <http://pair-direct.uspto.gov>. Should you have questions about acquiring access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*David P. Stitzel, Esq.*



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SUPERVISORY PATENT EXAMINER